

REMARKS

The Office Action mailed on December 17, 2001 has been received and reviewed. Claims 1-26 are in the case. Claims 1-26 stand rejected. For the reasons set forth below, Claims 1-26 are believed to be in condition for allowance.

REJECTION OF CLAIM 1 UNDER 35 U.S.C. § 103(a) OVER BARON ET AL. IN VIEW OF BLUM ET AL AND ALEXANDER ET AL.

Claim 1 stands rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,809,481 to Baron et al. (hereinafter "Baron") in view of U.S. Patent No. 5,805,164 to Blum et al. (hereinafter "Blum") and U.S. Patent No. 6,134,593 to Alexander et al. (hereinafter "Alexander"). Applicants respectfully traverse these rejections.

With respect to the Baron and Blum references, Applicant has previously asserted in the response to the Office Action mailed July 10, 2001 (Paper #16) that these references neither alone nor in combination can be construed to describe the invention of Applicants.

In addition, Applicant asserts that the Alexander reference cannot be combined with the art of record to produce Applicant's invention. The Alexander reference recites "a product distribution identifier...printed on a *label* affixed to a *compact disc* media storing the vendor software application" (Column 6, lines 42-45). The Examiner has simply provided a reference reciting a *compact disk media* and a *label* and claims that this in combination with the Baron and Blum would produce Applicant's invention to "one of ordinary skill in the art."

Applicant respectfully traverses this argument. First of all, the references (Baron, Blum, and Alexander) are not related art, and therefore, would not be obvious to combine to "one of

ordinary skill in the art.” Furthermore, Applicant asserts that the Examiner is simply picking and pulling elements from this incongruous assortment of patents in an attempt to produce Applicants invention. Applicant respectfully calls to the attention of the Examiner that “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 927 F.2d 1260. Moreover, “[o]ne cannot use hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch* 927 F.2d 1266. The disclosures from which the Examiner is picking and choosing are certainly isolated disclosures, and therefore, would not have been obvious to one of ordinary skill in the art to combine produce Applicant’s invention.

Referring back to the Alexander reference, Applicant asserts that the compact disk plays no part, nor is related to, the labeling of a product. Using a computer readable medium as part of a labeling system for a product is a key component of Applicant’s invention. The Alexander reference simply relates to automated methods for electronic software distribution, wherein commonly known identification codes, numbers, or the like that may be used to identify a distributed copy of software, in order for a manufacture to collect payment, or to prevent unauthorized use or distribution.

On the contrary, referring to claims 1, 11, and 18 of Applicant, the “product” and the “computer readable medium” are distinct elements. The computer readable medium serves as part or all of a labeling system provided for a selected product (*See Abstract*). In the Alexander reference, the “compact disk media” cannot be construed to play any part in the labeling of a product. To even make sense of the Alexander reference with respect to Applicant’s invention,

one would have to call the compact disk the “product,” and then attach another computer readable medium to the compact disk by way of a label, a structure clearly not taught nor suggested in any way by Alexander.

With respect to the Baron reference, Applicant recites a product label, a “label configured to be affixed to a product.” A product label, as that term is used in the specification of Applicant, is a device for labeling a product to be offered for sale. Applicant finds nothing in Baron to teach such a concept. Baron teaches “a lost property registration, identification and return system whereby lost property identified by an ID tag will be returned to its proper owner in the event the property is found.” Col. 5, lines 5-8. This is nothing more than the anciently known, returnable key fob for car keys or a hotel key that can be mailed to a clearing house for forwarding to the owner. This is just the same mechanical fob with the return-to-agent information.

Applicant finds nothing in Baron or Blum that teaches a product label relating to a product or a source of a product as those terms are defined in the specification. Thus Baron and Blum, neither alone nor together teach “a label configured to be affixed to product at a source thereof” and “configured to directly communicate first information corresponding to at least one of the product and a source of the product.” Baron teaches that the “tags’ recipients” are the ones who “are then intended to attach the tag to a personal item.” Col. 4, lines 28-29.

Applicant recites a label “configured to directly communicate first information corresponding to at least one of the product and a source of the product.” Such information is characteristic of a product label as required by Applicant and as disclosed in the specification repeatedly throughout pages 2-5. By contrast, Baron teaches no relationship between the information on his “tag” and the vendor, manufacturer, or other source of the product, nor any

information related to the product. Clearly, the system of Baron cannot be construed to be a product label.

In fact, Applicant finds nothing in Baron to suggest a product label as that term is used and defined by applicant throughout the specification, and specifically on pages 2-5. Applicant finds nothing to suggest any relationship between the information on the tag and the vendor of the article to which the tag is attached. By contrast, Baron teaches a tag for identifying "the location and contact information of a processing facility to be contacted in the event a tag is found." Col. 6, lines 56-57.

Applicant's label contains "a computer readable medium, storing instructions executable by a computer of a purchaser of the product." Applicant finds nothing to suggest any executables in Baron. At most, Baron's device contains information (data, not executables) concerning his service center and a code that may be associated by that center to the owner of the lost item. Baron teaches no embodiment of information of the type specified by Applicant, nor information that may be readable by "a computer of a purchaser" of a product. Notwithstanding the possibility of the processing facility reading a "bar code," "magnetic media codes," col. 7, lines 14-15 or "optical character recognition," col. 6, lines 66-67, to decode information, the purchaser at that time has lost the item and cannot possibly read the label. While the product is in the owner's possession, the owner has no motivation, need, nor capacity to read the information on the tag.

Applicant also fails to find a teaching in either cited reference of "a computer readable medium . . . coupled to the product by the label." A tag attached to a personal item by the tag's

recipient cannot fairly be construed to couple anything at the point of sale as a "product label" would do.

Blum is completely inapposite art. A "label" as that term is used in computer science, and in Blum, is a "virtual" item, a label consisting of one field of data in some type of record, by which label that record or some data in that record may be identified. Such data is of no use in labeling a product for sale to a purchaser as a product label must. Blum teaches "associating a pop-up list box with a particular one of the displayed field labels, the pop-up list box containing a plurality of available field labels, wherein the available field labels correspond respectively to different stored properties." Col. 8, lines 23-27. These field labels cannot fairly be construed to "couple" anything as that term is used and defined in the specification of Applicant and recited in the claims of Applicant.

Additionally, Applicant believes that the attached interview summary shows that the incorporated amendments distinguishes Applicant's invention over the art of record, and Blum adds nothing that could add to Baron the teachings required to form Applicant's device.

Applicant respectfully asserts that claim 1 is patentably distinct because a computer readable medium, storing instructions executable by a computer of a purchaser of the product, coupled to the product by the label, would not be obvious to one skilled in the art at the time of invention.

It has been well established that the teachings of Applicant's invention cannot be utilized to modify the prior art in order to obtain a structure similar to Applicant's invention. The prior art must per se teach Applicant's invention. In the present case, there is no teaching in any of the cited references or combining the references to obtain a novel combination of the present invention spelled out.

REJECTION OF CLAIMS 2 AND 4 UNDER 35 U.S.C. § 103(a) OVER BARON IN VIEW OF
BLUM AND ALEXANDER, AS APPLIED TO CLAIM 1 ABOVE, AND FURTHER IN VIEW
OF DLUGOS, SR. ET AL.

Claims 2 and 4 stand rejected under 35 U.S.C. § 103(a) over Baron in view of Blum and Alexander, as applied to claim 1 above, and further in view of U.S. Patent No. 5,153,842 to Dlugos, Sr. et al (hereinafter "Dlugos"). Dlugos teaches a "tracking label" affixed by a transporter and read periodically by that transporter to track a transported object. This is not a product label as that term is recited, defined, and used by Applicant, and does not contain the executable required by Applicant's claim.

Moreover, with respect to claim 4, Applicant finds in Dlugos no label that "is shaped to provide the first information through a trademark symbol corresponding to at least one of the product and the source of the product." Dlugos teaches that the "label is generally in the form of a conventional integrated circuit card (or 'smart card') and includes a card shaped plastic body." This cannot fairly be construed to provide first information through a trademark symbol. Applicant recites in claim 1, that the first information relates to at least one of the product and a source thereof. Applicant fails to find any suggestion in Dlugos of providing such "first information."

Moreover, with respect to claim 4, Applicant finds in Dlugos no "trademark symbol." The applicant, therefore, asserts that claims 2 and 4 are allowable.

REJECTION OF CLAIMS 5-6 UNDER 35 U.S.C. § 103(a) OVER BARON IN VIEW OF
BLUM AND ALEXANDER, AS APPLIED TO CLAIM 1 ABOVE, AND FURTHER IN VIEW
OF CHRISTENSEN ET AL.

Claims 5-6 stand rejected under 35 U.S.C. § 103(a) over Baron in view of Blum and Alexander, as applied to claim 1 above, and further in view of U.S. Patent 5,710,886 to Christensen et al. (hereinafter "Christensen").

Even if all the elements of a claim are disclosed in the various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art as to why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

The prior art simply does not provide any impetus to do what the Applicant has done and, accordingly, the Office Action fails to make a prima facie case of obviousness. The rejection is respectfully traversed.

Applicant recites "second information" that includes at least one of "product facts, source facts, new product facts, service facts, a game, a data-gathering interface, a test, a browser, a launcher, and a network identifier corresponding to a location of additional information." Applicant finds no suggestion in the cited references of second information as that information is recited, defined, and relied upon by Applicant.

By contrast, Christensen teaches coupons sent on their own behalf as an advertising medium. He suggests nothing to associate his diskette with a label of another product sold with the aid of his diskette as a label thereof. He specifically teaches against a product label, by suggesting direct mail advertising. Col. 5, lines 41-42.

Moreover, browsing gives no suggestion other than the conventional use of that term as a reader reviews, peruses, or browses a list or reading material contained on the diskette. A browser is a term of art in computer science and is so used by Applicant. No such suggestion is found by Applicant in the Christensen reference. For these reasons, Applicant asserts that claims 5-6 are allowable.

As to claims 7-8, the Office Action includes discussion of claims 7-8 in this section without stating specifically a basis for rejecting either claim. Applicant assumes that claims 7-8 stand rejected under 35 U.S.C. § 103(a) over Baron.

Applicant finds in Baron no teaching that a "product is placed with respect to the label to protect the label prior to purchase." Conversely, Baron teaches away from affixing a label to a product prior to purchase of the product. Baron teaches that the "tags' recipients" are the ones who "are then intended to attach the tag to a personal item." Col. 4, lines 28-29. Baron's "personal item" cannot fairly be construed to be a product protecting a label prior to purchase.

Applicant finds in Baron no hang tag associated with a label that is associated with a product. Baron appears to be a "lost-and-found-type" tag system which does not teach or disclose any use of a tag with products. For these reasons, Applicant asserts that claims 7-8 are allowable.

REJECTION OF CLAIM 3 UNDER 35 U.S.C. § 103(a) OVER BARON, IN VIEW OF BLUM, ALEXANDER AND DLUGOS, AS APPLIED TO CLAIM 2 ABOVE, AND FURTHER IN VIEW OF MARKMAN.

Claim 3 stands rejected under 35 U.S.C. § 103(a) over Baron, in view of Blum, Alexander, and Dlugos, as applied to claim 2 above, and further in view of U.S. Patent No. 5,794,213 to Markman (hereinafter "Markman").

The Office Action fails to meet a prima facie case of obviousness. Applicant does not find any teaching in Baron, Blum, Dlugos, or Markman of first information "contained in a selection of color on the label." Applicant understands Markman to suggest color coding tags used by a vendor to group and sort articles such as dry cleaning. Because Applicant finds no suggestion in the references to use a selection of color to convey information on a label related to a product, Applicant submits that the references fail to teach, alone or together the limitations of claim 3.

Applicant cannot find in the references together nor alone a teaching of the product label concept in the first place, nor any suggestion that could motivate anyone of ordinary skill in the art to combine their teachings. Moreover, a product label, and a direct mail advertisement are antithetical to one another. Likewise, information used by a vendor or services in-house is antithetical to information provided to a purchaser. Therefore, Applicant asserts that claim 3 is allowable.

REJECTION OF CLAIMS 9-10 UNDER 35 U.S.C. § 103(a) OVER BARON IN VIEW OF
BLUM AND ALEXANDER, AS APPLIED TO CLAIM 1 ABOVE, AND FURTHER IN VIEW
OF TSAI ET AL.

Claims 9-10 stand rejected under 35 U.S.C. § 103(a) over Baron in view of Blum and Alexander, as applied to claim 1 above, and further in view of U.S. Patent 5,825,292 to Tsai et al. (hereinafter "Tsai").

Even if all the elements of a claim are disclosed in the various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art as to why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

The prior art simply does not provide any impetus to do what the Applicant has done and, accordingly, the Office Action fails to make a prima facie case of obviousness. The rejection is respectfully traversed.

Applicant recites a "label configured to directly communicate first information corresponding to at least one of the product and a source of the product." Applicant finds in the cited references no such structure. Baron teaches no relationship between the information on his "tag" and the vendor, manufacturer, or other source of the product, nor any information related to the product. In contrast to the claimed invention, Tsai teaches "specialized markers which are useful in magnetic-type electronic article surveillance (EAS) systems." Col. 1, lines 9-11. Such markers are used to deter theft of an object and not to "communicate first information corresponding to at least one of the product and a source of the product."

Moreover, Applicant finds no reasonable motivation to combine the cited references. It would not be obvious to a person skilled in the art to combine an anti-theft marker device with Baron or Blum. For these reasons, Applicant asserts that claims 9-10 are allowable.

REJECTION OF CLAIMS 11-12, 14, 18, 19, 21, 23, AND 24-26 UNDER 35 U.S.C. § 102(b)
OVER DLUGOS IN VIEW OF ALEXANDER

Claims 11-12, 14, 18, 19, 21, 23, and 24-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dlugos in view of Alexander.

The defense of anticipation is improper. For a prior art reference to anticipate, every element of the claimed invention must be identically disclosed in a single prior art reference; and those elements must be arranged or connected together in a single reference in the same way as specified in the patent claim. The cited reference does not meet that test. Also, all elements of the claims must be considered. Claims are to be construed in light of the specification as it would be understood by those skilled in the art. Arbitrary definitions are to be avoided, as the words of the claim cannot be read in a vacuum, but must be viewed in the context of the application at hand.

As to claim 11, claim 11 teaches “a computer-readable medium coupled to the packaging by the label and containing instructions executable on a computer of a user.” Applicant finds in Dlugos no identical structure performing the same functions in the same way. Dlugos teaches a structure where “information from the label is read by a parcel scale or computerized parcel shipping system (also known as a manifesting system) or a terminal interfaced thereto for such purposes as selecting routes and shipping modes, calculating shipping charges, preparing manifests, billing, maintaining account records.” Col. 8, lines 45-50. This cannot fairly be construed to be identical in structure and function to the claimed invention.

First of all, the label is not a “product label” as discussed above, since it is applied by a transporter for use by the transporter, is not readable by a computer of a purchaser, and is not

even related to the product, its source, and so forth as those terms are explained by Applicant in the specification.

Moreover, the label of Dlugos, if it contains information, contains only operational data, not executables, as defined and recited by applicant. Applicant does not find any mention in Dlugos of "instructions executable on a computer of a user." It is not a fair interpretation to equate "a computer of a user" to a "computerized parcel shipping system." On the contrary, Dlugos teaches, "it is assumed that label or parcel is provided with marking circuitry or such other type of marker as may be sensed by parcel sensor." Col. 6, lines 53-56. Dlugos thus teaches against any readability by a purchaser, which would possibly defeat the purpose of his system. It appears that a special unique protocol must be used with the parcel shipping system that would be available to the shipper, and not compatible with any ordinary digital computer of a user.

Furthermore, Claim 11 relates to products and a computer-readable medium attached to the product by a label. Products are articles offered for sale in the retail market. The products are directed toward purchasers. Dlugos' system is used by shippers or transporters whose product is the shipping itself. Contrary to the claimed invention, Dlugos appears to relate to parcels and other articles transported by common carriers or stored in warehouses. Dlugos teaches that "'parcel' means an item to be mailed or shipped." Applicant understands that the integrated circuits on the parcels taught by Dlugos are not directed toward use by the purchaser of the product. Applicant, therefore, asserts that the products of the claimed invention are not identical to the parcels taught in Dlugos.

Applicant finds none of the significant elements recited in claim 11 to be disclosed in Dlugos. Therefore, Applicant respectfully submits that claim 11 cannot be anticipated by Dlugos.

Applicant asserts that the Alexander reference can not be combined with the Dlugos reference to provide the same invention as described in claim 11 for the reasons discussed above in relation to claim 1.

As to Claim 14, Applicant finds no disclosure by Dlugos of a label “shaped to provide the first information through a trademark symbol corresponding to at least one of the product and the source of the product.” Specifically, Applicant finds no trademark symbol in Dlugos for communicating first information. Therefore, Applicant asserts that Dlugos cannot anticipate Claim 14.

As to Claim 18, significant claim elements have been disregarded. For example, tethers appear to be completely absent in the reference. Claim 18 teaches a structure where “a label is configured to be attached to a tether” and “the tether couples the label to the exterior of the product.” The Office Action fails to point out any tether in the Dlugos reference, and Applicant finds no tether or identical structure in the Dlugos reference. Therefore, Dlugos cannot possibly anticipate claim 18.

Applicant asserts that the Alexander reference can not be combined with the Dlugos reference to provide the same invention as described in claim 18 for the reasons discussed above in relation to claim 1.

As to claim 21, Applicant finds in Dlugos no label “shaped to provide the first information through a trademark symbol corresponding to at least one of the product and the

source of the product.” Applicant finds no disclosure in the reference of a trademark symbol to communicate first information. Applicant therefore asserts that Dlugos cannot anticipate claim 21.

As to Claim 23, Applicant finds no structure disclosed in Dlugos defining “an opening to an interior of the product.” Applicant therefore asserts that Dlugos cannot anticipate claim 23.

As to Claim 24, Applicant asserts that Claim 24 is allowable for the same reasons discussed above in relation to Claim 11.

As to Claim 26, Applicant finds no disclosure in Dlugos of a label “coupled to the exterior of the product by a flexible member.” Specifically, Applicant finds no mention in Dlugos of a flexible member structure. Applicant therefore asserts that Dlugos cannot anticipate claim 26.

In the interview of February 26, 2001, it is noted that the art of record is avoided by the cited amendments, subsequently incorporated. Dlugos was of record at that time. Applicant respectfully asserts that no new structures nor teachings related to the recited claim elements were introduced by the references relied upon herein. Each cited reference still fails to disclose or teach “a computer-readable medium coupled to the packaging by the label and containing instructions executable on a computer of a user.”

REJECTION OF CLAIM 13 UNDER 35 U.S.C. § 103(a) OVER DLUGOS IN VIEW OF
ALEXANDER AS APPLIED TO CLAIM 12 ABOVE, AND FURTHER IN VIEW OF
MARKMAN.

Claim 13 stands rejected under 35 U.S.C. § 103(a) over Dlugos in view of Alexander, as applied to claim 12 above, and further in view of Markman.

Applicant does not find any teaching in Dlugos or Markman of first information “contained in a selection of color on the label.” Applicant understands Markman to suggest color coding tags used by a vendor to group and sort articles such as dry cleaning. Because Applicant finds no suggestion in the references to use a selection of color to convey information on a label related to a product, Applicant submits that claim 13 is in condition for allowance.

REJECTION OF CLAIM 20 UNDER 35 U.S.C. § 103(a) OVER DLUGOS IN VIEW OF ALEXANDER AS APPLIED TO CLAIM 19 ABOVE, AND FURTHER IN VIEW OF MARKMAN.

Claim 20 stands rejected under 35 U.S.C. § 103(a) over Dlugos in view of Alexander, as applied to claim 19 above, and further in view of Markman.

Applicant asserts that claim 20 is in condition for allowance for the reasons discussed above in relation to claim 13.

REJECTION OF CLAIM 15 UNDER 35 U.S.C. § 103(a) OVER DLUGOS IN VIEW OF ALEXANDER AS APPLIED TO CLAIM 11 ABOVE, AND FURTHER IN VIEW OF CHRISTENSEN.

Claim 15 stands rejected under 35 U.S.C. § 103(a) over Dlugos in view of Alexander as applied to claim 11 above, and further in view of Christensen.

Applicant asserts that claim 15 is allowable for the same reasons discussed above in relation to claim 5.

REJECTION OF CLAIM 16 UNDER 35 U.S.C. § 103(a) OVER DLUGOS IN VIEW OF ALEXANDER AS APPLIED TO CLAIM 11 ABOVE, AND FURTHER IN VIEW OF BARON.

Claim 16 stands rejected under 35 U.S.C. § 103(a) over Dlugos in view of Alexander as applied to claim 11 above, and further in view of Baron.

Claim 16 recites a hang tag associated with a label that is associated with a product. Baron appears to be a “lost-and-found-type” tag system which does not teach or disclose use of a tag with products. Dlugos appears to disclose labels associated with parcels. Furthermore, combining Baron and Dlugos does not appear to result in tags associated with products. Applicant finds no suggestion to combine labels with products, and asserts that claim 16 is in condition for allowance.

REJECTION OF CLAIM 17 UNDER 35 U.S.C. § 103(a) OVER DLUGOS IN VIEW OF ALEXANDER AS APPLIED TO CLAIM 11 ABOVE, AND FURTHER IN VIEW OF TSAI.

Claim 17 stands rejected under 35 U.S.C. § 103(a) over Dlugos in view of Alexander as applied to claim 11 above, and further in view of Tsai.

Applicant asserts that claim 17 is allowable for the reasons discussed above in relation to claims 9-10.

REJECTION OF CLAIM 22 UNDER 35 U.S.C. § 103(a) OVER DLUGOS IN VIEW OF
ALEXANDER AS APPLIED TO CLAIM 18 ABOVE, AND FURTHER IN VIEW OF
CHRISTENSEN.

Claim 22 stands rejected under 35 U.S.C. § 103(a) over Dlugos in view of Alexander as applied to claim 18 above, and further in view of Christensen.

Applicant asserts that claim 22 is allowable for the same reasons discussed above in relation to claim 5.

Each of dependent claims 2-10, 12-17, 19-23, and 25-26 depend either directly or indirectly from independent claims 1, 11, 18, or 24, which Applicant respectfully asserts are allowable. Therefore, Applicant asserts these claims are allowable at least by way of their dependency.

Applicant asserts that claims 1-26 are in condition for allowance based on the attached interview summary. The amendments agreed upon at the interview with the Examiner have been incorporated and are believed sufficient to overcome any rejection based on previously cited prior art.

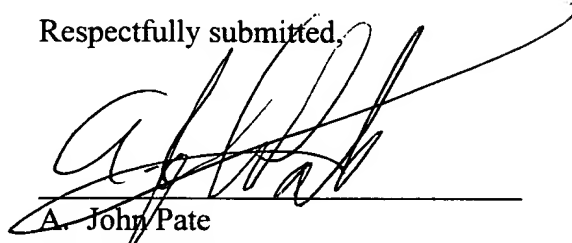
Other amendments made address minor technical corrections. Moreover, all dependent claims are deemed allowable as dependent from allowable base and intervening claims.

In view of the foregoing, Applicant respectfully requests reconsideration of all pending claims and submits that claims 1-26 are in condition for immediate allowance. In the event the Examiner finds any remaining impediment to the prompt allowance of any of these claims which

could be clarified in a telephone conference, the Examiner is respectfully urged to initiate the same with the undersigned.

DATED this 14th day of March, 2002.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'A. John Pate', written over a horizontal line.

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